REMARKS

In the October 17, 2005 Office Action, the Examiner raised certain issues related to the abstract and specification. The amendments set forth above are intended to address both of the issues raised by the Examiner.

The Examiner also rejected claim 1 (and dependent claims 2-10) under 35 U.S.C. § 112 based upon the use of "said computer" in section (g) of claim 1. Claim 1 has now been amended to clarify this matter. As was intended originally and should be clear from the amendment, either the first computer system or any of the second computer systems can be used by an operator of that computer to place the panel into a page and communicate to the first computer system that the page is acceptable.

The Examiner also rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over Popa et al (U.S. Patent No. 5,991,783) in view of Nakai et al (Publication No. US2004/003411 A1 dated January 1, 2004). For the foregoing reasons, this rejection is respectfully traversed.

First, it should be noted that the Nakai et al publication is not prior art to the subject application. As set forth in greater detail below, the effective date of this reference is June 27, 2003 and applicants completed their invention before

that date. As set forth in 37 C.F.R. § 1.131, the "effective date of a U.S. patent, U.S. patent application, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e). Thus, a reference is prior art if either of two tests is met. Under the first test, the publication date of the reference is dispositive. The publication date of the Nakai et al reference was January 1, 2004, more than four months after the subject application was filed. Thus, the Nakai et al reference does not constitute prior art under the first test set forth in 37 C.F.R. §1.131.

The second test set forth in 37 C.F.R. §1.131 relates to the requirements of 35 U.S.C. § 102(e). This section of the patent code sets forth two alternatives for determining when a reference is effective. Under the first alternative, the reference is prior art if it is an application for a patent, published under Section 122(b), or filed in the United States before the invention by applicant for patent. Thus, under this test one is to look at the U.S. filing date of the reference. That date, in the case of the Nakai et al reference is June 27, 2003. As discussed in greater detail below, applicants completed their invention before that date. Thus, under this alternative, the Nakai et al reference is not prior art. The

second alternative set forth in Section 102(e) relates to "a patent granted on an application for patent by another filed in the United States before the invention by applicant for patent, except that an international application filed under the treaty defined in Section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in English language." This alternative certainly does not make the Nakai et al reference prior art. First, the reference is not a patent. Second, the treaty defined in Section 351(a) is the "Patent Cooperation Treaty". While the Nakai et al publication references earlier Japanese applications, neither constitute "an application filed under the treaty defined in Section 351(a)". Further, there is no indication that either of these applications "designated the United States" or were "published under Article 21(2) of the PCT in the English language". In fact, because they were Japanese applications and not PCT applications, these requirements could not have been met by either of these Japanese applications. Thus, the effective date of the Nakai et al reference is no earlier than June 27, 2003. As discussed below, applicants completed their invention well before June 27, 2003.

Pursuant to 37 C.F.R. 1.131, applicants submit herewith the Declaration of Ronald Wrenholt, one of the named inventors of the subject application. Mr. Wrenholt's Declaration is accompanied by two exhibits. Exhibit A is a guidebook bearing a copyright date earlier than June 27, 2003. This guidebook was used and distributed by the assignee as part of its yearbook publishing business. As discussed in detail in the Wrenholt Declaration, the guidebook points out how the various steps in the claimed method were performed by Lifetouch and its customers prior to June 27, 2003.

Exhibit B to the Wrenholt Declaration is a log created and maintained by Lifetouch related to the various Lifetouch teams involved in commercializing the method covered by the claims of the subject application. All of the dates in this log report predate June 27, 2003. This log also confirms that yearbook pages were successfully created as described in Exhibit A using the method set forth in applicants' claims. This all occurred well in advance of June 27, 2003. The Wrenholt Declaration compares the claimed method to the information provided in both Exhibits A and B and clearly demonstrates that the invention claimed was not only conceived but also reduced to practice well in advance of June 27, 2003. While the specific dates contained in the exhibits have been masked, the exhibits, along with Mr.

Wrenholt's Declaration, confirm that the invention was complete in advance of June 27, 2003 such that the Nakai et al reference should not be considered prior art in applying 35 U.S.C. § 103.

Further, even if the Nakai et al reference were prior art, it, in combination with the Popa et al reference, does not teach applicants' claimed invention. For example, the Examiner suggests on page 6 of the Office Action that Popa et al's master data file is a "panel" of the type required by applicants' invention. The Examiner then says: "The master data file (panel) contains a low-resolution version of the image (thumbnail/preview image) (50 in. Fig. 2a), along with a high-resolution version of the image." The Examiner then discusses uses of the high-resolution version of the image. This discussion points out why Popa's master data file is, in fact, not a "panel" as that term is used in applicants' invention.

First, applicants' "panel" does not contains high-resolution images. This is because applicants' panel is used to expedite transmission between the first computer system and one of the second computers. Thus, low-resolution rather than high resolution images are included in the "panel".

Second, claim 1 imposes certain requirements related to the creation of the panel. Specifically, applicants' claims require that the panel be created and stored as a file by the first

computer based upon a desired page layout and manner in which images should be grouped. In the yearbook context, for example, the page layout for the page is selected and then the photos of students are grouped as desired, e.g. by grade, by teacher, or the like. The panel is created accordingly. There is no suggestion in Popa et al that the master file 110 is created in this fashion.

Third, with applicants' invention, the panel is placed into a page using either the first computer system or one of the second computers. The user then signals when the page into which the panel is inserted is acceptable. Then, the first computer system modifies the acceptable page changing the low-resolution images to high-resolution images for printing. None of these steps are not taught in Popa et al.

Nakai et al fails to teach any of the features of claim 1. There is no discussion of a panel or anything comparable to applicants' panel in Nakai et al. There is also no discussion in Nakai et al related to the creation or subsequent use of such a panel. Nakai et al was only cited because it shows a network server and user terminals. Nakai et al, however, does not show the use of such equipment required by the method of applicants' claim 1.

In view of the foregoing, it is respectfully submitted that Nakai et al is not prior art and, even if it were prior art, it does not teach applicants' claimed invention either by itself or in combination with Popa et al. Therefore, applicants respectfully submit that this application is in condition for allowance. Such action is most earnestly solicited.

Respectfully submitted,

NIKOLAI & MERSEREAU, P.A.

Thomas J. Nikolai, #19283
820 International Centre
900 Second Avenue So.
Minneapolis, MN 55402
(Phone: 612) 339-7461
Fax: (612) 349-6556

CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment in application Serial No. 10/624,207, filed July 22 2003, is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, postage prepaid, on Oct. 16, 2006.

Bonnie M. Ryan
On Behalf of Thomas J. Nikolai